

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

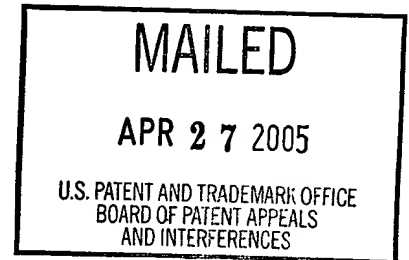
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte STANLEY B. MILLER, III, LOUIS PATRONE and
PATRICIA A. ZIARNIAK

Appeal No. 2005-0737
Application No. 09/768,016

ON BRIEF



Before ELLIS, ADAMS and MILLS, Administrative Patent Judges.

MILLS, Administrative Patent Judge.

REMAND TO THE EXAMINER

This is an appeal under 35 U.S.C. §134 from the examiner's final rejection of claims 3-6, 10-12 and 38-46. The Answer indicates that claims 19-27 would be allowable if rewritten in independent form. Answer, page 6. Claims 47 and 48 have been withdrawn from appeal by the appellants. Brief, page 1.

Our consideration of the record leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application to the examiner to consider the following issues and take appropriate action.

Claims 3, 7, 28, 38 and 39 are illustrative of the claims on appeal and read as follows:

3. An acid-gas absorbing tablet comprising in relatively sufficient proportions by weight at least one absorbent, a binder, a first basic salt, a second basic salt, said first basic salt being primarily associated with said absorbent, and said second basic salt being primarily associated with said binder.

7. A method of absorbing acid gases from an electronic device comprising the steps of providing an acid-gas absorbing tablet comprising in relatively sufficient proportions by weight at least one adsorbent, a binder, a first basic salt primarily associated with said adsorbent, a second basic salt primarily associated with said binder, and installing said acid-gas adsorbing tablet in said electronic device.

28. A method of fabricating a mixture for producing an acid-gas absorbing tablet comprising the steps of providing an adsorbent and a first basic salt, blending said adsorbent and said first basic salt to produce a first mixture, providing a binder and a second basic salt, blending said binder and said second basic salt to produce a second mixture, and blending said first and second mixtures.

38. An acid-gas absorbing tablet comprising a first blended mixture of at least one adsorbent and a basic salt, a second blended mixture of a binder and a second basic salt, and a blended mixture of said first and second blended mixtures.

39. An acid-gas absorbing tablet comprising first blended mixture means for absorbing an acid-gas by converting said acid gas into a salt and carbon dioxide and water which is adsorbed by an adsorbent therein for subsequent evaporation to the atmosphere, and second blended mixture means including a binder for binding said second blended mixture means with said first blended mixture means and for both absorbing said acid-gas by converting said acid-gas into a salt and carbon dioxide and water which is adsorbed by said adsorbent for subsequent evaporation to the atmosphere and for converting said acid-gas which is adsorbed and desorbed from said binder into a salt and carbon dioxide and water which is adsorbed by said adsorbent for subsequent evaporation to the atmosphere.

The prior art references cited by the examiner are:

McLaughlin et al. (McLaughlin)	4,395,347	July, 1983
Osborne et al. (Osborne)	4,855,276	Aug., 1989
Tanzer et al. (Tanzer)	5,037,412	Aug., 1991
Tuma et al. (Tuma)	6,146,446	Nov., 2000

Grounds of Rejection

Claims 3-6 and 38-46 stand rejected under 35 U.S.C. 103(a), as obvious over Tuma.

Claims 3-6 and 38-46 stand rejected under 35 U.S.C. 103(a), as obvious over Tuma and McLaughlin.

Claims 3-6 and 38-46 stand rejected under 35 U.S.C. 103(a), as obvious over Tuma and Tanzer.

Claims 7, 10-12 and 28-37 stand rejected under 35 U.S.C. 103(a), as obvious over Tuma and Osborne.

1. Claim language indefinite

Upon review of the claims in the present application, we find the claim language, in some instances, to be indefinite. In so finding, we note that analyzing claims based on "speculation as to meaning of the terms employed and assumptions as to the scope of such claims" is legal error. In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). Therefore, we cannot and do not reach the merits of the rejections under 35 U.S.C. § 103(a) before us. We remand the application to the examiner to address the following claim ambiguities with an appropriate rejection under 35 U.S.C. § 112, second paragraph. By way of example, below are particular instances of claim indefiniteness.

a) In claims 3 and 7 the phrases, “ first basic salt primarily associated with said adsorbent” and “second basic salt primarily associated with said binder” are unclear. It is unclear from reading the specification what is meant by the term “primarily associated”. While the examiner speculates that the term in the claims means “mixing of the first and second basic salt with the adsorbent and binder, respectively, altogether”, appellants argue that the term does not mean mixing together. Answer, page 7; Reply Brief, page 3. The application is remanded to develop the record further and to determine, with the help of appellants, what is meant by the term “primarily associated.” Do appellants mean some type of physical bonding of the adsorbent and binder to the first basic salt, and second salt, respectively. If so, what type of binding? Do appellants merely mean mixing the two “primarily associated” components together in the same vessel followed by combination of all four components (adsorbent, first basic salt, binder, second basic salt)?

b) The terms “first basic salt” and “second basic salt” in claims 3, 7, 28 and 38 are unclear. It is unclear whether the claims require that the first and the second basic salts be different salts. On the one hand the appellants appear to use different language for the two salts, i.e., “first” and “second”, thus requiring two different salts. On the other hand, as noted by the examiner, according to the specification the first basic salt and the second basic salt may be selected from the same markush group of

salts, e.g. sodium and potassium carbonates and bicarbonates. See also, claim 5. The examiner, with the help of appellants, upon remand of the application should clarify on the record whether, if the first basic salt is potassium carbonate, the second basic salt must be a salt other than potassium carbonate, or whether, one of ordinary skill in the art can select any salt in the Markush group (claim 5), including the same salt, such as potassium carbonate.

c) Claim 39 is in the “means plus function” format. 35 U.S.C. § 112, sixth paragraph. To satisfy the requirements of 35 U.S.C. § 112, second paragraph, when 35 U.S.C. § 112, sixth paragraph, is invoked, the corresponding structures must be described in the specification. The examiner must first determine whether there is support, i.e., whether one skilled in the art would have been able to identify the structure, material or acts for performing the recited function from review of the specification. In claim 39, the phrases “first blended mixture means for absorbing an acid-gas by converting said acid gas into a salt and carbon dioxide and water which is adsorbed by an adsorbent therein for subsequent evaporation to the atmosphere”, and “second blended mixture means including a binder for binding said second blended mixture means with said first blended mixture means,” are unclear. It is unclear whether the “first blended mixture means for absorbing” and the “second blended mixture means including a binder for binding said second blended mixture means with said first blended mixture means” must necessarily include first and second basic salts

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to function according to the claim, or whether the "blended mixture means for absorbing", need only include the adsorbent, and the "second blended mixture means" need only include the binder. Upon return of the application to the examiner, the examiner should clarify the scope of this terminology on the record.

In view of the foregoing, upon return of the application to the examiner, the examiner should determine whether rejections of the claims under 35 U.S.C. § 112, second paragraph, are appropriate.

2. Withdrawn Claims

As indicated above, the appellants have withdrawn claims 47 and 48 from appeal. Brief, page 1. Such withdrawal operated as an authorization by the appellants to cancel said claims. See, M.P.E.P. §§ 1214.05 and 1215.03. Thus upon return of the application to the examining corps, the examiner should exercise his authority to cancel these claims.




CONCLUSION

In view of the above, we cannot reach the merits of the present appeal. The application is remanded to the examiner for further clarification and development of the issues regarding claim interpretation in the application. See, 35 U.S.C. § 112, second and sixth paragraphs.

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This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board. No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REMANDED

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JOAN ELLIS)	
Administrative Patent Judge)	
)	
DONALD E. ADAMS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
DEMETRA J. MILLS)	
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